

09-13-04

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Dated: 9/9/04

Signature: Maria Reen

(Maria Reen)

Docket No.: 60542(49811)  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Masahito Watanabe et al.

Application No.: 10/749,806

Confirmation No.: 6518

Filed: December 31, 2003

Art Unit: 1626

For: PROCESS FOR PRODUCING  
OPTICALLY ACTIVE COMPOUND

Examiner: Not Yet Assigned

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT (IDS)**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 1.97, Applicant(s) hereby make of record the following additional documents. A PTO Form SB/08 and a full copy of each of these documents accompany this statement.

Applicant(s) have become aware of the following documents, cited in an International Search Report issued April 26, 2004, during the prosecution of international application no. EP 04 00 0296, which corresponds to the above referenced application, and in accordance with 37 CFR 1.97(c) and (e)(1) or (b)(3), hereby submit(s) these documents for the Examiner's consideration. These documents are cited on the enclosed PTO Form SB/08, and a copy of the International Search Report and each document cited thereon are enclosed as well.

This statement is not to be interpreted as a representation that the cited documents are material, that an exhaustive search has been conducted, or that no other relevant information exists. Nor shall the citation of any document herein be construed *per se* as a representation that such document is prior art. Moreover,


Applicant(s) understand(s) the Examiner will make an independent evaluation of the cited documents.

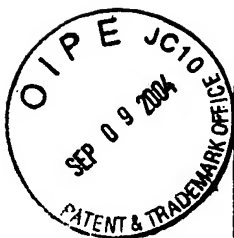
The undersigned hereby certifies that each item contained in this Supplemental Information Disclosure Statement was cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

The Director is hereby authorized to charge any credits or deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 60542(49811). A duplicate copy of this paper is enclosed.

Dated:

Respectfully submitted,

By   
Jeffrey D. Hsi  
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| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><i>(Use as many sheets as necessary)</i> |   |    |   | Application Number       | 10/749,806-Conf. #6518 |
|  |   |    |   | Filing Date              | December 31, 2003      |
|  |   |    |   | First Named Inventor     | Masahito Watanabe      |
|  |   |    |   | Art Unit                 | 1626                   |
|  |   |    |   | Examiner Name            | Not Yet Assigned       |
| Sheet  | 1 | of | 1 | Attorney Docket Number   | 60542(49811)           |

| U.S. PATENT DOCUMENTS |                       |   |                                |  |   |
|-----------------------|-----------------------|---|--------------------------------|--|---|
| Examiner Initials*    | Cite No. <sup>1</sup> | Document Number<br>Number-Kind Code <sup>2</sup> (if known) | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
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| FOREIGN PATENT DOCUMENTS |                       |  |                                |  |   |                |
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| Examiner Initials*       | Cite No. <sup>1</sup> | Foreign Patent Document<br>Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known) | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear | T <sup>6</sup> |
|                          | BA                    | JP-10 130289   | 05-19-1998                     |  |   |                |

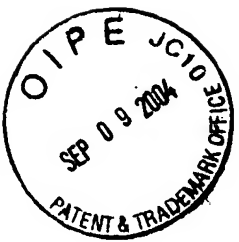
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| NON PATENT LITERATURE DOCUMENTS |                       |  |                |
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| Examiner Initials*              | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.          | T <sup>2</sup> |
|                                 | CA                    | Database accession number 2003:634256  |                |
|                                 | CB                    | Suzuki et al., "Catalytic asymmetric Michael reactions using a chiral rhodium complex"; 2001; Tetrahedron: Asymmetry, Vol. 12; 1077-1081.  |                |
|                                 | CC                    | Sasai et al., "Catalytic Asymmetric Michael Reactions Promoted by the La-Na-BINOL Complex (LSB). Enantioface Selection on Michael Donors"; 1996; Tetrahedron Letters, Vol. 37(31); 5561-5564.  |                |
|                                 | CD                    | Prabakaran et al., "Asymmetric Michael addition reactions using a chiral La-Na aminodiolate catalyst", 2002; Tetrahedron Asymmetry, vol. 13; 1053-1058.  |                |
|                                 | CE                    | Kumaraswamy et al., "Calcium-BINOL: a novel and efficient catalyst for asymmetric Michael reactions", 2001; Tetrahedron Letters, vol. 42; 8515-8517.   |                |
|                                 | CF                    | Noyori et al., "Asymmetric Transfer Hydrogenation Catalyzed by Chiral Ruthenium Complexes", 1997; Acc. Chem. Res., vol.30(2); 97-102.  |                |
|                                 | CG                    | Haack et al., "The Catalyst Precursor, Catalyst, and Intermediate in the RuII-Promoted Asymmetric Hydrogen Transfer between Alcohols and Ketones", 1997; Angew. Chem. Int. Ed. Engl., vol. 36(3);285-288.  |                |
|                                 | CH                    | Watanabe et al., "Enantioselective Michael Reaction Catalyzed by Well-Defined Chiral Ru Amido Complexes: Isolation and Characterization of the Catalyst Intermediate, Ru Malonato Complex Having a Metal - Carbon Bond", 2003; J. Am. Chem. Soc., vol. 125(25);7508-7509 |                |

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Application No. (if known): 10/749,806

Attorney Docket No.: 60542(49811)

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